

REMARKS

In the Office Action dated November 17, 2004, the Examiner rejected claims 1-4, 7-10, 13-15, 26-28, and 31-33 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Under 35 U.S.C. § 102(b), the Examiner rejected claims 16, 17, 23, 29, and 30 as being anticipated by a prison; claims 16, 23, and 29 as being anticipated by the Pentagon; and claims 8-10, 24, 25, 31, 32, and 34 as being anticipated by U.S. Patent Application Publication No. 2002/0118111 A1 of *Brown et al.* ("*Brown*"). Finally, the Examiner rejected claims 1-7, 11-23, 26-30, and 33 under 35 U.S.C. § 103(a) as being obvious over *Brown*.

Section 101 Rejections

Claims 1-4, 7-10, 13-15, 26-28, and 31-33 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant contends that the claims as originally filed clearly recite statutory subject matter under the test set forth by the Federal Circuit and followed by the M.P.E.P.: that the claimed invention as a whole produces a "useful, concrete and tangible result...." *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998); see M.P.E.P. § 2106. Although the Examiner acknowledges this test in the Office Action, he appears to apply a different test, i.e., "[w]hether the invention is within the technological arts...." Office Action, p. 2. The source and authority of this test are unknown, and Applicant submits that the claims should be examined using the guidance provided by the Federal Circuit in *State Street* and following the instructions set forth in the M.P.E.P.

Despite these objections and in order to move this application forward, Applicant has amended claims 1, 8, 13, 26, and 31 to satisfy the "technological arts" requirement

imposed by the Examiner. Accordingly, Applicant requests the withdrawal of the section 101 rejections of claims 1, 8, 13, 26, and 31, and the claims that depend therefrom.

Section 102 Rejections

Under 35 U.S.C. § 102(b), the Examiner rejected claims 16, 17, 23, 29, and 30 as being anticipated by a prison and claims 16, 23, and 29 as being anticipated by the Pentagon. He also rejected claims 8-10, 24, 25, 31, 32, and 34 as being anticipated by *Brown*. To anticipate a claim, the reference must teach every element of the claim. M.P.E.P. § 2131.01 (8th ed. 2001, revised February 2003).

Claim 16, as amended, recites a plurality of second secure areas, one of which is assigned to a customer and includes a piece of equipment to be rented by the customer in combination with a computer that records status information about operation of the piece of equipment after the customer accesses the second secure area. Although secure facilities such as a prison or the Pentagon may have a plurality of secure areas assigned to individuals, these do not include a piece of equipment to be rented by the customer or a computer that records status information about operation of the piece of equipment. Because claim 16 contains elements not taught by the examples cited by the Examiner, the claim is not anticipated and should be allowed. Claims 17 and 23 depend from amended claim 16 and indirectly contain its recitations. Therefore, for at least the reasons given above, the Examiner's examples fail to disclose every element of claims 17 and 23 and Applicant requests the withdrawal of the section 102 rejections of these claims.

Claim 29, as amended, recites a plurality of second secure areas accessible from a first secure area, one of which is assigned to a customer and includes goods to be

purchased by the customer. Although secure facilities such as a prison or the Pentagon may have a plurality of secure areas assigned to individuals, these do not include goods to be purchased by the customer. Because claim 29 contains elements not taught by the examples cited by the Examiner, the claim is not anticipated and should be allowed.

Claim 30 depends from amended claim 29 and indirectly contains its recitations. Therefore, for at least the reasons given above, the Examiner's examples fail to disclose every element of claim 30 and Applicant requests the withdrawal of the section 102 rejection of this claim.

Claims 8-10, 24, 25, 31, 32, and 34 were rejected as being anticipated by *Brown*. Because the reference does not disclose each and every element recited in claims 8-10, 24, 25, 31, 32, and 34, as amended, the rejections under 35 U.S.C. § 102(b) should be withdrawn.

Claim 8, as amended, recites sensing an identifier on a piece of equipment and status information related to operation of the piece of equipment as the equipment is moved within a predetermined distance from an exit of the secure area. *Brown* does not teach this combination of claim elements. Instead, the reference merely discloses tracking the existence, location, or movement of objects in inventory using a model, serial number or other identifier. *Brown*, ¶¶ 17, 22. This is not the same as sensing status information about the operation of a piece of equipment. Because *Brown* does not disclose every element of claim 8, the claim is not anticipated by the reference and Applicant requests the withdrawal of the section 102 rejection of claim 8.

Claims 9-10 depend from claim 8 and indirectly contain its recitations.

Therefore, for at least the reasons given above, *Brown* fails to disclose every element of claims 9-10 and Applicant requests the withdrawal of the section 102 rejections of these claims.

Claim 24, as amended, recites a sensor that senses status information about operation of the piece of equipment in combination with a computer that records the status information when the customer removes the piece of equipment from the secure area. Nothing in *Brown* discloses these claim elements. Instead, the reference merely discloses tracking the existence, location, or movement of objects in inventory using a model, serial number or other identifier. *Brown*, ¶¶ 17, 22. This is not the same as sensing or recording status information about operation of a piece of equipment. Because *Brown* does not disclose every element of claim 24, the claim is not anticipated by the reference and Applicant requests the withdrawal of the section 102 rejection of claim 24.

Claim 25 depends from claim 24 and indirectly contains its recitations.

Therefore, for at least the reasons given above, *Brown* fails to disclose every element of claim 25 and Applicant requests the withdrawal of the section 102 rejection of this claim.

Claim 31, as amended, recites sensing an identifier on a piece of equipment and status information related to the customer's use of the piece of equipment as the equipment is moved within a predetermined distance from an entrance of the secure area. Nothing in *Brown* discloses these claim elements. Instead, the reference merely discloses tracking the existence, location, or movement of objects in inventory

using a model, serial number or other identifier. *Brown*, ¶¶ 17, 22. This is not the same as sensing information related to a customer's operation of a piece of equipment. Because *Brown* does not disclose every element of claim 31, the claim is not anticipated by the reference and Applicant requests the withdrawal of the section 102 rejection of claim 31.

Claim 32 depends from claim 31 and indirectly contains its recitations. Therefore, for at least the reasons given above, *Brown* fails to disclose every element of claim 32 and Applicant requests the withdrawal of the section 102 rejection of this claim.

Claim 34 recites, among other things, a sensor that senses an identifier on goods and directs the access controller to allow the customer to remove the goods from the secure area when the identifier on the goods corresponds to the identity of the customer. Nothing in *Brown* teaches these claim elements. Instead, the system of *Brown* discloses a locking mechanism that allows an individual to enter a locked storage room and a system that records objects that are removed from the room. *Brown*, ¶¶ 25, 27. The reference does not mention directing a controller to allow the individual to leave the room when an identifier on goods corresponds to the individual. Because *Brown* fails to teach every element of claim 34, the section 102 rejection of the claim should be withdrawn.

Section 103 Rejections

Finally, the Examiner rejected claims 1-7, 11-23, 26-30, and 33 under 35 U.S.C. § 103(a) as being obvious over *Brown*. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the reference must teach or suggest each and every element

recited in the claims. M.P.E.P. § 2143.03 (8th ed. 2001, Revised February 2003). This requirement must "be found in the prior art, and not be based on applicant's disclosure." Id. at § 2143. *Brown* fails to teach or suggest every element of amended claims 1-7, 11-23, 26-30, and 33, and Applicant therefore requests the withdrawal of the section 103 rejections of these claims.

Claim 1, as amended, recites a plurality of second secure areas, one of which is assigned to the customer and includes a piece of equipment to be rented by the customer. As the Examiner admits, *Brown* does not disclose a second secured area containing an item to be rented. Office Action, p. 5. The Examiner suggests that an obvious variation on *Brown* would be a restricted access section of a video store. Even if the Examiner's suggested modification is obvious, such a variation of the reference still would not teach or suggest a plurality of second secure areas, one of which is assigned to the customer and includes a piece of equipment to be rented by the customer, as recited in amended claim 1. Because *Brown* does not teach or suggest every element of claim 1, the claim is not obvious over the reference and Applicant requests the withdrawal of the section 103 rejection of claim 1.

Claims 2-7 depend from claim 1 and they are nonobvious at least for the reasons given above with respect to claim 1. Further, these claims contain other recitations not taught or suggested by *Brown*, such as recording a difference between what the customer takes and a list of equipment (e.g., claim 3) and preventing the customer from leaving if what the customer takes does not match the list of equipment (e.g., claim 4). For their dependence from nonobvious claim 1 and for these additional

reasons, Applicant requests that the section 103 rejections of claims 2-7 be withdrawn.

Claims 11-12 depend from amended claim 8 and therefore recite, among other things, sensing an identifier on a piece of equipment and status information related to operation of the piece of equipment as the equipment is moved within a predetermined distance from an exit of the secure area. For at least the reasons given above regarding claim 8, *Brown* fails to teach or suggest this claim element. Therefore, Applicant requests the withdrawal of the section 103 rejections of dependent claims 11 and 12.

Claim 13, as amended, recites providing a customer access to one of a plurality of secure areas based upon a sensed identity, the one secure area assigned to the customer and containing a piece of equipment to be rented by the customer. *Brown* does not teach or suggest such a method. Instead, *Brown* discloses a single storage room or area containing inventory. In the Office Action, the Examiner argued that an obvious variation of *Brown* would be a restricted access area in a video store. Office Action, p. 5. However, even if this variation would have been obvious, it does not teach a plurality of secure areas, one assigned to the customer and containing a piece of equipment to be rented by the customer, as recited in amended claim 13. Because *Brown* does not teach or suggest every element of claim 13, the claim is not obvious over the reference and Applicant requests the withdrawal of the section 103 rejection of claim 13.

Claims 14-15 depend from claim 13 and they are nonobvious at least for the reasons given above with respect to claim 13. Therefore, Applicant requests that the section 103 rejections of claims 14-15 be withdrawn.

Claim 16, as amended, recites a plurality of second secure areas, one of which is assigned to a customer and includes a piece of equipment to be rented by the customer in combination with a computer that records status information about operation of the piece of equipment after the customer accesses the second secure area. As the Examiner admits, *Brown* does not disclose a second secured area containing an item to be rented. Office Action, p. 5. The Examiner suggests that an obvious variation on *Brown* would be a restricted access section of a video store. Even if the Examiner's suggested modification is obvious, such a variation of the reference still would not teach or suggest a plurality of second secure areas, one of which is assigned to the customer and includes a piece of equipment to be rented by the customer, as recited in amended claim 16. Furthermore, nothing in the reference teaches or suggests a computer that records status information about operation of the piece of equipment. Because *Brown* does not teach or suggest every element of claim 16, the claim is not obvious over the reference and Applicant requests the withdrawal of the section 103 rejection of claim 16.

Claims 17-23 depend from claim 16 and they are nonobvious at least for the reasons given above with respect to claim 16. Therefore, Applicant requests that the section 103 rejections of claims 17-23 be withdrawn.

Claim 26, as amended, recites a plurality of second secure areas, one of which is assigned to the customer and includes goods to be purchased by the customer. As

the Examiner admits, *Brown* does not disclose a second secured area. Office Action, p. 5. The Examiner suggests that an obvious variation on *Brown* would be a restricted access section of a video store. Even if the Examiner's suggested modification is obvious, such a variation of the reference still would not teach or suggest a plurality of second secure areas, one of which is assigned to the customer and includes goods to be purchased by the customer, as recited in amended claim 26. Because *Brown* does not teach or suggest every element of claim 26, the claim is not obvious over the reference and Applicant requests the withdrawal of the section 103 rejection of claim 26.

Claims 27-28 depend from claim 26 and they are nonobvious at least for the reasons given above with respect to claim 26. Further, these claims contain other recitations not taught or suggested by *Brown*, such as recording a difference between what the customer takes and a list of goods (e.g., claim 28). For their dependence from nonobvious claim 26 and for such additional reasons, Applicant requests that the section 103 rejections of claims 27-28 be withdrawn.

Claim 29, as amended, recites a plurality of second secure areas accessible from a first secure area, one of which is assigned to a customer and includes goods to be purchased by the customer. As the Examiner admits, *Brown* does not disclose a second secured area. Office Action, p. 5. The Examiner suggests that an obvious variation on *Brown* would be a restricted access section of a video store. Even if the Examiner's suggested modification is obvious, such a variation of the reference still would not teach or suggest a plurality of second secure areas accessible from a first secure area, one of which is assigned to a customer and includes goods to be

purchased by the customer, as recited in amended claim 29. Because *Brown* does not teach or suggest every element of claim 29, the claim is not obvious over the reference and Applicant requests the withdrawal of the section 103 rejection of claim 29.

Claim 30 depends from amended claim 29 and is nonobvious at least for the reasons given above with respect to claim 29. Thus, Applicant requests the withdrawal of the section 103 rejection of claim 30.

Claim 33, as amended, recites using a computer to sense an identifier on goods and status information related to the goods as the goods are moved within a predetermined distance from an exit of a secure area. Nothing in *Brown* discloses these claim elements. Instead, the reference merely discloses tracking the existence, location, or movement of objects in inventory using a model, serial number or other identifier. *Brown*, ¶¶ 17, 22. This is not the same as sensing both an identifier of goods and status information related to the goods. Because *Brown* does not teach or suggest every element of claim 33, Applicant requests the withdrawal of the section 103 rejection of claim 33.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

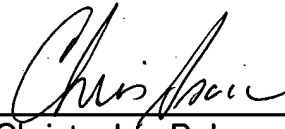
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 1, 2005

By: _____


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